

REMARKS

Introduction

Claims 1-37, 39-56, 58-77, 79-98, 100-119 and 121-128 were pending in this case. Applicants have amended claims 1, 13, 34, 53, 74, 95, and 116 to more particularly define the claimed invention. Applicants have cancelled claims 2, 5, 18, 19, 38-40, 57-59, 78-80, 99-101, and 120-122 without prejudice. Applicants have added new claims 129-134. No new matter has been added and the amendments are fully supported by the original specification. Reconsideration of this application in light of the following remarks is hereby respectfully requested.

Summary of Office Action

Claims 1, 3-4, 6-17, and 20-37, 41-56, 60-77, 81-98, and 102-115 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1 and 13 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 1, 3-4, 6-17, and 20-33 have been rejected under 35 U.S.C. § 103(a) as being anticipated by Gebb U.S.

Patent No. 6,067,532 (hereinafter "Gebb")¹. Claims 34-37, 41-56, 60-77, 81-98, 102-119, and 123-128 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Gebb as applied in claims 1 and 13 in view of official notice regarding website administration. (Office Action, pp. 3-6). These rejections are respectfully traversed.

Summary of Telephonic Interview

Applicants wish to thank Examiner Zureta for his time during the July 23, 2004 telephonic interview. During the interview, the Examiner's rejections were discussed. Applicants agreed to amend the claims to more particularly define the claimed invention.

Summary of Applicants' Claimed Invention

Applicants' claimed invention is directed to systems and methods for a first consumer to transfer an item with

¹ Claims 1, 3-4, 6-17, and 20-33 originally had the feature of a "consumer selectable interface." Claims 34-37, 41-56, 60-77, 81-98, 102-119, and 123-128 originally had the feature of a "select group of consumers." Applicants have referenced the 35 U.S.C. § 103(a) claim rejections accordingly.

restricted transferability (e.g., airline ticket, concert ticket, sporting event ticket, option contract rights, hotel reservation, restaurant reservation, car rental) to a second consumer. A first consumer at a consumer computer sends to a transfer system a request to transfer an item with restricted transferability to another consumer. Upon receipt of the request, the transfer system requests authorization to transfer the item from the provider of the item. The provider can authorize the transfer and can place restrictions on the transfer of the item. The restrictions can include, for example, a minimum transfer price and a maximum number of items that can be transferred. The transfer system can then implement the restrictions and present information on the item to a second consumer. The first consumer can select how information on the item is to be presented: in a bidding interface or an advertising interface. Upon a second consumer purchasing the item, the transfer system arranges for the transfer of the item from the first consumer to the second consumer.

The Rejection Under 35 U.S.C. § 101

Claims 1, 3-4, 6-17, 20-37, 41-56, 60-77, 81-98, and 102-115 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Examiner contends that the claimed invention is "an abstract idea that is not within the technological arts [and that does not] apply, involve, use, or advance the technological arts[, thereby failing] to promote the 'progress of science and the useful arts'" (Office Action, p. 3, lines 19-23). This rejection is respectfully traversed.

Per the Examiner's suggestion on how to overcome this rejection, applicants have amended independent claims 1, 13, 34, 53, 74, and 95 to more particularly define the phrase "consumer selectable interface." In particular, applicants have amended the claims to state that the first consumer's request to transfer (or sell) an item includes "an interface selected by the first consumer, the consumer selectable interface comprising one of an advertising interface to advertise availability of the item and a bidding interface to solicit bids for the item." Information on the item is presented to a second consumer in this consumer selectable interface.

Applicants respectfully submit that applicants' claims meet the requirements set forth under 35 U.S.C. § 101. In particular, the claims are directed to systems and methods for electronically arranging for a first consumer to transfer an item to a second consumer. As discussed in the background section of applicants' specification, many items (e.g., airline tickets, concert tickets, sporting event tickets) are sold by providers to consumers with restrictions on the transferability of the items. These restrictions may prevent the transfer of the items to other consumers to prevent competition with the providers (e.g., selling at a lesser price than the provider). At the same time, these restrictions may greatly burden the consumers who may not be able to use the item (e.g., due to unforeseeable business or personal obligations) (applicants' specification, p. 1, line 12 to p. 2, line 26).

Applicants' claims are directed to systems and methods that enable a consumer to transfer such an item with restricted transferability while at the same time preventing the consumer from competing with the provider. An electronic trading arrangement is provided in which a consumer can request to sell an item and in response, authorization is obtained from the

provider prior to presenting the item for sale to other consumers. The provider, in authorizing the sale of the item, can also place restrictions on the sale of the item (e.g., minimum transfer price, maximum number of items, contract extension).

For the forgoing reasons, applicants respectfully submit that the claims promote the progress of science and use arts by applying, involving, using, and advancing the technological arts by providing for such interactions, and therefore include statutory subject matter. The rejection under 35 U.S.C. § 101 should be withdrawn.

The Rejection Under 35 U.S.C. § 112

Claims 1 and 13 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention². More particularly, the Examiner contends that the phrase "consumer

² The Examiner has asserted that this phrase is unclear in claims 1 and 13. Applicants have added this phrase to the following independent claims: 34, 53, 74, 95, and 116.

selectable interface" is unclear (Office Action, p. 4, lines 4-7).

Per the Examiner's suggestion on how to overcome this rejection, applicants have amended independent claims 1, 13, 34, 53, 74, 95, and 116 to more particularly defined the phrase "consumer selectable interface." In particular, applicants have amended the claims to state that the first consumer's request to transfer (or sell) an item includes "an interface selected by the first consumer, the consumer selectable interface comprising one of an advertising interface to advertise availability of the item and a bidding interface to solicit bids for the item." Information on the item is presented to a second consumer in this consumer selectable interface.

Moreover, applicants respectfully submit that the phrase "consumer selectable interface" is clear from applicants' specification and figures. Applicants' FIG. 2 is a flow diagram illustrating a "process for contacting a providing and providing notification to a consumer" (applicants' specification, p. 4, lines 23-26). Flow diagram 20 includes step 23 in which a user can request to transfer an item. At step 23, "[t]he consumer may request to transfer the item by auction or posting an

advertisement for the item." (Applicants' specification, FIG. 2; p. 7, lines 3-5, emphasis added).

Applicants' FIG. 3 is a flow diagram illustrating a "process for trading and transferring an item between consumers" (applicant's specification, p. 4, lines 27-30). Flow diagram 30 includes a step 31 in which a transfer system retrieves information regarding the transfer of the item from a consumer request and a step 32 in which the transfer system determines whether the consumer wants to auction or advertise the item. The information retrieved at step 31 includes the interface selected by the consumer (e.g., to post an advertisement and accept the first bid or to auction the item). Then at step 32, the transfer system determines "whether first consumer 3 wants to advertise or auction the item." If the consumer decides to auction the item, "the system may add the item to a bidding interface at step 33." If the consumer decides to post an advertisement, "system 2 may then add the item to an advertising interface." (Applicants' specification, FIG. 3; col. 9, line 13 to p. 10, line 28, emphasis added).

From the foregoing, it has been shown that applicants' use of the phrase "consumer selectable interface" is fully

supported by the specification and figures and is particularly defined in the amended independent claims. The rejection under 35 U.S.C. § 112 should be withdrawn.

The Rejection Under 35 U.S.C. § 103(a)³

Applicants respectfully submit that Gebb does not show or suggest "receiving a request to transfer [or sell] the item from the first consumer, an interface selected by the first consumer, the consumer selectable interface comprising one of an advertising interface to advertise availability of the item and a bidding interface to solicit bids for the item," and "presenting information on the item to a second consumer in the consumer selectable interface" as recited in independent claims 1, 13, 34, 53, 74, 95, and 116 (emphasis added). In fact, the Examiner admits that "Gebb does not explicitly disclose that the system and method incorporates a 'consumer selectable

³ Applicants have amended all the independent claims 1, 13, 34, 53, 74, 95, and 116 to incorporate the feature of a "consumer selectable interface." Claims 34, 53, 74, 95, and 116 have been amended to delete the feature of a "select group of consumers." Accordingly, applicants will address the Examiner's rejection of claims 1 and 13 as they apply to claims 34, 53, 74, 95, and 116.

interface'" (Office Action, p. 6, lines 13-14). Instead, in Gebb, the system automatically selects the manner in which an event ticket is to be sold without the seller's input. Gebb describes this throughout the specification:

Depending on the laws of the particular state and the agreement with the specific arena, team or other entity, the system automatically determines the price for the ticket. Pursuant to a venue agreement or state laws restricting the resale value of a ticket, the system will set a fair market price for the tickets based on a bidding process. If the state has restriction on the resale of a ticket, the system will simply add a nominal service fee to the face value of the tickets.

(Gebb, col. 2, lines 43-50, emphasis added).

The present system preferably includes various servers, databases and networking devices which are suitably configured to accept tickets from individual sellers, post the tickets on a central database for redistribution, establish a market price based on demand and/or a service fee (as discussed below, this feature may not be available in certain states due to restrictions on the resale of tickets or at certain arenas due to prior agreements)...

(Gebb, col. 3, lines 43-10, emphasis added).

If the State has enacted laws restricting the resale of tickets at a price higher than the face value of the ticket or if an agreement with a particular arena prevents a higher price, the system will only add a transaction fee which conforms to any transaction fee limitation enacted by the particular State or within an arena agreement ... If the state or arena does not restrict the resale of tickets at

an increased price, the ticket information will also be placed in an offer database ...

(Gebb, col. 7, lines 59-67, emphasis added).

In Gebb, the system automatically determines whether the event ticket will be sold 1) at a market price based on demand and/or a service fee or 2) in an offer database based on state or arena restrictions. The system does not allow a seller to select the manner in which an event ticket is to be sold. Thus, Gebb does not show or suggest allowing a first consumer to present information on an item to a second consumer in a consumer selectable interface as recited in applicants' independent claims 1, 13, 34, 53, 74, 95, and 116.

In addition, the Examiner has failed to point to any particular reference that shows an electronic trading arrangement having the features disclosed in applicants' independent claims 1, 13, 34, 53, 74, 95, and 116.

Moreover, applicants respectfully submit that the Examiner has failed to point to any suggestion or motivation to modify Gebb to include the features of applicants' claimed invention, as defined by independent claims 1, 13, 34, 53, 74, 95, and 116. In particular, the Examiner merely states that "it would have been obvious to one skilled in the art at the time to

allow the seller to choose a preferred method of sale, i.e., auction or set-price, in order to give the seller the most flexibility, thereby enhancing customer satisfaction" (Office Action, p. 6, lines 14-17).

In fact, applicants respectfully submit that Gebb teaches away from being modified to include this feature of applicants' independent claims 1, 13, 34, 53, 74, 95, and 116. Gebb is directed to an "automated system for posting event tickets for sale, allowing purchase of the tickets at face value or at a market price based on demand and/or a service fee ..." (Gebb, col. 1, lines 5-7). Gebb describes a system that automatically determines the resale price of an event ticket based on the laws of a particular state or an agreement with a specific arena (Gebb, col. 2, lines 42-50). Gebb does not describe a system directed "to allow the seller to choose a preferred method of sale, i.e., auction or set-price, in order to give the seller the most flexibility, thereby enhancing customer satisfaction" as asserted by the Examiner.

Therefore, because Gebb, whether taken alone or in combination with what is obvious to one skilled in the art, fail to show all the features of applicants' claimed invention,

because there is no prior art motivation to modify Gebb to include all the features of applicants' claimed invention, and because Gebb, in fact, teaches away from applicants' claimed invention, applicants' independent claims 1, 13, 34, 53, 74, 95, and 116 are in condition for allowance. Claims 3-4 and 6-12, which depend from independent claim 1, claims 14-17 and 20-33, which depend from independent claim 13, claims 35-37 and 41-52, which depend from independent claim 34, claims 54-56 and 60-73, which depend from independent claim 53, claims 75-77 and 81-94, which depend from independent claim 74, and claims 96-98 and 102-115, which depend from independent claim 95, and claims 117-119 and 123-128, which depend from independent claim 116, are also in condition for allowance.

New Claims 129-134

Applicants respectfully submit that new claims 129-134 are allowable at least because they depend from their respective independent claims, which has been shown above to be in condition for allowance.

Application No. 09/670,900
Amendment Dated August 13, 2004
Reply to Office Action of April 13, 2004

Conclusion

Applicants respectfully submit that this application is now in condition for allowance. Accordingly, prompt consideration and allowance of this application are respectfully requested.

Respectfully Submitted,

Evelyn C. Mak

Evelyn C. Mak
Registration No. 50,492
Attorney for Applicants

FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
(212) 596-9000